

Appl. No. 09/823,787  
Amdt. dated July 15, 2005  
Reply to Office Action of March 15, 2005

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to Fig. 5. Please replace the originally filed sheet with the attached replacement sheet.

Attachment: Replacement sheet, Fig. 5.

### **REMARKS/ARGUMENT**

Claims 1-26 are pending in the application upon entry of the present amendment. No claim amendments are herein submitted.

Figure 5 of the specification as filed is herein amended to correct a duplicate reference numeral. In Figure 5 as originally filed, the reference numeral "135c" is duplicated to refer to two different features. The attached replacement Figure 5 corrects the duplication. Corresponding text on pages 13 and 14 of the specification as filed are similarly amended to correct the duplication. No new matter is introduced.

### **Rejections under 35 USC §103**

Claims 1-3, 5-12, and 14-26 were rejected under 35 USC §103(a) as being unpatentable over Robbin (U.S. Patent No. 6,731,312), and the article "Oscar MP3 Player (2), Part (2): operation and measurement results," by Kurpiers et al., hereinafter *Kurpiers*. The rejections are traversed, and Applicants request reconsideration.

Applicants' independent claim 1 recites a method for recording MP3 files to optical media. The method includes browsing MP3 files at a source location, selecting MP3 files to record to a destination optical media, and constructing a playlist of the selected MP3 files to be executed from the destination optical media. The method then provides for recording the selected MP3 files and the playlist to the destination optical media.

In independent claim 10, Applicants claim computer readable media having program instructions for recording data to optical media. The computer readable media includes program instructions for receiving a project selection, for configuring and formatting a recording session in accordance with the received project selection, and for parsing source files and filtering out those files not in a target format of the received project selection. Further, the computer readable media includes program instructions for receiving a selection of source files to be recorded to the optical media, for constructing a playlist of the source files to be executed from the destination optical media, and for recording the selection of source files and the playlist to the optical media.

In independent claim 15, Applicants claim an optical media recording program configured to record data to optical media. The optical media recording program includes instructions for searching for music data files from at least one source. The searching is configured to only display the music data files at the exclusion of non-music data files. Further, the optical media recording program includes instructions for enabling the selection of particular ones of the music data files, and for building a data structure including the selected music data files. The data structure further includes a playlist data structure defining an order for playing the selected music files. Finally, the optical media recording program includes instructions for recording the selected music data files including the playlist data structure to an optical disc from the at least one source. The selected music data files are configured to be accessed for playing from the optical disc in the order defined by the playlist data structure.

Finally, in independent claim 21, Applicants claim program instructions in a computer system which includes an attached peripheral storage device and an attached optical disc recording device. The computer system includes a processor and memory for executing program instructions stored at least in part in the attached storage device. The program instructions include instructions for receiving a project selection, and for configuring a recording session in accordance with the received project selection. Also included are instructions for parsing source files and filtering out those files not in a format of the received project selection, and for receiving a selection of source files to be recorded to a destination optical media. Finally, the instructions include instructions for constructing a playlist of the source files to be executed from the destination optical media, and for recording the selection of source files and the playlist in a format of the received project selection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. (MPEP §2143). The mere fact that a reference can be

modified does not render the resultant modification obvious unless the prior art also suggest the desirability of the combination. That is, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Applicants respectfully submit a *prima facie* case of obviousness is not supported against Applicants' claimed invention.

For at least the reason that the asserted combination fails to teach or suggest all the claim limitations, a *prima facie* case is not supported against Applicants' independent claims 1, 10, 15, and 21. As stated by the Office, "He [Robbin] does not specifically state that the playlist is recorded along with the mpeg-1 (mp3) files on the CD. ... *Kurpiers* does not teach a method of recording files, however *Kurpiers* teaches the use of playlists found on CD's with mp3 files." In fact, *neither reference* teaches or suggests the recording of the playlist to the destination optical media. In fact, *both* of the asserted references teach the "use" of playlists. See, for example, col. 3, lines 34-44, of Robbins in which a user-defined playlist is utilized in the media player application. As cited by the Office, *Kurpiers* describes the use of playlists at page 42 under the section entitled "Playlists and Programmes." Applicants, however, have claimed recording a playlist along with selected MP3 files to a destination optical media, and the asserted combination simply fails to teach or suggest this claim feature.

For at least the reason that the teaching or suggestion to make the claimed combination is not found in the prior art, the asserted combination fails to support a *prima facie* case of obviousness against Applicants' independent claims 1, 10 15, and 21. According to the Office, "It would have been obvious for one of ordinary skill in the art to combine the teaching of Robbin and *Kurpiers* for the purpose of keeping track of the large amount of media files that can be contained on the CD." While this, theoretically, *could* be a rationale for a combination, the Office has failed to identify or support that such rationale is found in the prior art. Further, a playlist does not "keep track" of media files in large or small volume. As described by Applicants in the specification as filed at page 3, lines 20-24, "A playlist, as is known, is a list of songs in the order of desired playback. The playlist created with prior art, as noted, is valid only for the selected files so long as they remain in their source location or locations. This is because the prior art

methods, while allowing some limited capability to make a playlist, provide no capability to project the selected files, in a desired order, to the destination.” The Office has done nothing more than reiterate that which Applicants described in the application as filed: that playlists are known in the prior art, but that nothing in the prior art enables the projection of selected files, in a desired order, according to and along with a playlist to a destination location. In order to “keep track of” a large amount of media files on a CD, an index or file manager program, directory structure, etc., might be the appropriate structure or application. A playlist, however, has a very different function. The Office has neither asserted a combination that teaches or suggests all the claim limitations of Applicants’ independent claims 1, 10, 15, and 21, nor identified a motivation to combine as asserted in the prior art.

For at least these reasons, Applicants respectfully submit that independent claims 1, 10, 15 and 21 are patentable under 35 USC §103(a) over Robbin and *Kurpiers*. Dependent claims 2-3, 5-9, 11-12, 14, 16-20, and 22-26, each of which depend from one of independent claims 1, 10, 15, and 21, are patentable for at least the same reasons. Applicants therefore respectfully request that these rejections be withdrawn.

Claims 4 and 13 were rejected under 35 USC §103(a) as being unpatentable over Robbin and *Kurpiers* as above, and further in view of the DARTECH, Inc., DART CD-Recorder, Version 4.1, brochure. Applicants traverse these rejections, and request reconsideration.


Dependent claim 4 depends from independent claim 1. Dependent claim 13 depends from independent claim 10. For at least the reasons that independent claims 1 and 10 are patentable as described above, Applicants respectfully submit that claims 4 and 13 are patentable over the cited prior art. Applicants therefore respectfully request that these rejections be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration of claims 1-26. Applicants submit that all claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. If Examiner has any

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questions concerning the present Amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900, ext. 6905. If any additional fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. ROXIP204). A copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, LLP

  
Rick von Wohld, Esq.  
Reg. No. 48,018

710 Lakeway Drive, Suite 200  
Sunnyvale, California 94085  
**Customer Number 25920**